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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,614	07/08/2003	Michael A. Funari	644-031014	8274

28289 7590 03/11/2005

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EXAMINER

JACYNA, J CASIMER

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/615,614	Applicant(s) FUNARI ET AL. eb	
	Examiner J. Casimer Jacyna	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 12-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12292003</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election with traverse of group II, claims 7-11 in the reply filed on 1/18/2005 is acknowledged. The traversal is on the ground(s) that there is no serious burden. This is not found persuasive because the separate claim groupings meet the criteria for independent inventions as set forth in the MPEP and they are separately classified wherein it is a burden to examine additional inventions. Applicant regards all patents classified in the same class, such as class 251, to have the same classification. This is incorrect. There are 369 subclasses in class 251 and the full classification address involves both the class and the subclass. Applicant appears to be contending that because the cited patents are all classified in class 251, the entire class must be searched. Note that each patent has not been searched in all of the subclasses in class 251, but only a few of the subclasses have been chosen for a search. Being in different subclasses with class 251 does constitute separate classification. In regard to claims 12-16 belonging to group II, group III claims are drawn to the combination of a flush valve assembly that includes a diaphragm and additional elements. Claim 12 includes a diaphragm and a filter insert. Whereas group II claims are limited to only the diaphragm and do not include any additional combination elements such as a filter.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-6 and 12-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/18/2005.

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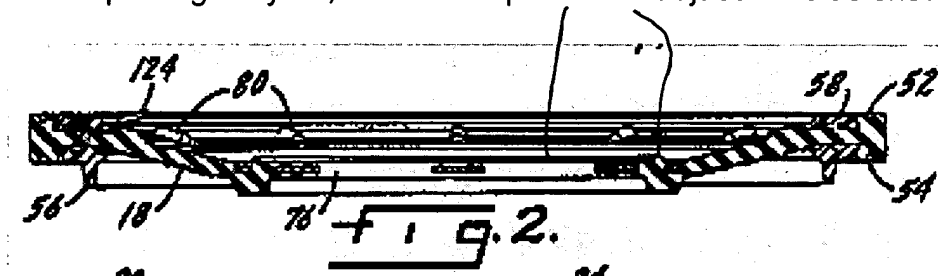
3. The abstract of the disclosure is objected to because the title may only be either "Abstract" or "Abstract of the Disclosure". Correction is required. See MPEP § 608.01(b).
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson (5,967,182). Wilson/182 discloses a flexible two sided diaphragm including a center passageway 76, an annular protrusion adjacent 76 as shown in figure 2,

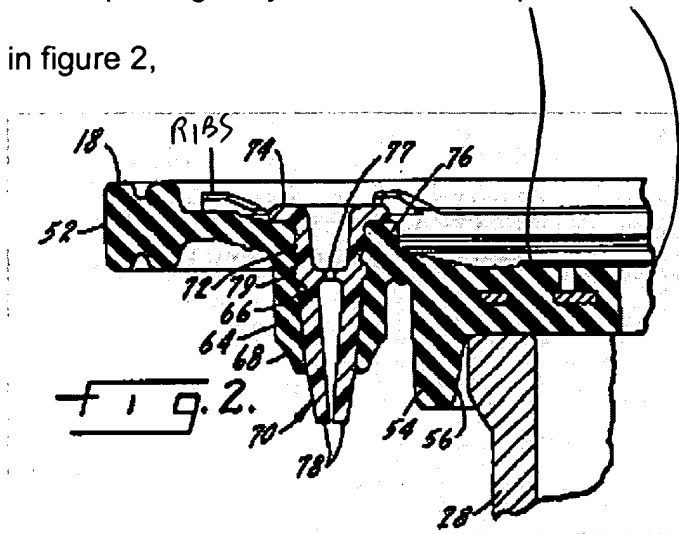


protruding ribs 80 on the same diaphragm side as the annular protrusion as claimed with a gap or recess between the ribs and the protrusion, with the side having the ribs and protrusion is shown as concave in figure 2 as claimed, and an orifice (see claim 9) 84, 86 that is capable of receiving a filter as claimed.

6. Claims 7, 9, 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson (6,616,119). Wilson/119 discloses a flexible two sided diaphragm including a

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center passageway with an annular protrusion adjacent the central passage as shown in figure 2,



tapered protruding ribs on the same diaphragm side as the annular protrusion as claimed with a gap or recess between the ribs and the protrusion, with the side having the ribs and protrusion is shown as concave in figure 2 as claimed, and a filter opening at 70.

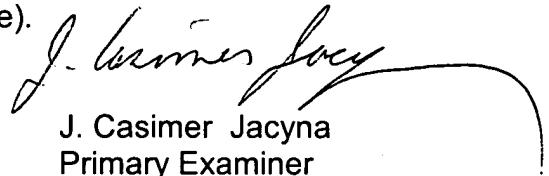
7. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Casimer Jacyna whose telephone number is 571-272-4889. The examiner can normally be reached on Wed. thru Fri. 9AM-7PM, Mon. 7AM-1PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 703-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


J. Casimer Jacyna
Primary Examiner
Art Unit 3751

JCJ